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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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7590 04/25/2003

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EXAMINER

WRIGHT, SONYA N

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1626

DATE MAILED: 04/25/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/914,884

Applicant(s)

BEATCH ET AL.

Examiner

Sonya Wright

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-89 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-89 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 1-89 are pending in this application.

Election/Restrictions

Due to the numerous variables in the claims, e.g., n, X, Y, R1, R2, R3, R4, R5, etc. . . and their widely divergent meanings, a precise listing of inventive groups can not be made. The following groups are exemplary:

Group I, claims 1-89 drawn to compounds of formula (I), wherein n is 1; X is a direct bond; Y is a direct bond; R13 is hydrogen or C1-C6alkyl; R1 and R2 are independently selected from hydrogen, or C1-C8alkyl; R3 and R4 are independently attached to the cycloalkyl ring shown in formula (I) at other than the 1 and 2 positions and are independently selected from hydrogen, and C1-C6alkyl; R5 is selected from hydrogen and C1-C6alkyl; A is selected from C5-C12 alkyl; classified in various classes and subclasses.

Group II, claims 1-89 drawn to compounds of formula (I), wherein n is selected from 2; X is selected from a direct bond; Y is selected from a direct bond; R13 is selected from C3-C8cycloalkyl; R1 and R2, when taken together with the nitrogen atom to which they are directly attached in formula (I) form a morpholinyl ring; R3 and R4 are independently attached to the cycloalkyl ring shown in formula (I) at other than the 1 and 2 positions and are independently selected from hydroxy; R5 is selected from aryl and benzyl; A is a C3-C13carbocyclic ring; classified in class 544 and subclass 63+.

Group III, claims 1-89 drawn to compounds of formula (I) wherein n is selected from 3; X is selected from -C(R6,R14)-Y-; Y is O; R13 is benzyl; R1 and R2 are independently

selected from C7-C12aralkyl; R3 and R4 are independently attached to the cycloalkyl ring shown in formula (I) at other than at the 1 and 2 positions and are independently selected from C1-C6alkoxy; R5 is selected from aryl; R6 is hydrogen; R14 is aryl; A is ring system (VI); Z is N; R12 is bromine, chlorine, or fluorine; classified in class 548, subclass 452+.

Group IV, claims 1-89 drawn to compounds of formula (I) wherein n is selected from 2; X is selected from -C(R6,R14)-Y-; Y is S; R13 is selected from benzyl; R1 and R2 are independently selected from C3-C8hydroxyalkyl; R3 and R4 are independently attached to the cycloalkyl ring shown in formula (I) at other than the 1 and 2 positions and are independently selected from hydroxy; R5 is C1-C6alkyl; R6 and R14 are taken together with the carbon to which they are attached to form a spiro C3-C5cycloalkyl; A is selected from ring system (VI); and Z is S; classified in class 549, subclass 41+.

In accordance with 37 CFR 1.499, Applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted. Again, this list is not exhaustive, because setting forth an exhaustive list would be impossible under the time constraints due to the sheer volume of subject matter instantly claimed. Therefore, Applicant may choose to elect a single invention by identifying another specific embodiment not listed in the exemplary groups of the invention and examiner will endeavor to group the same.

The claims herein lack unity of invention under PCT Rule 13.1 and 13.2 since the compounds defined in the claims lack a significant structural element qualifying as the special technical feature that defines a contribution over the prior art. The claims are

drawn to a compound of formula (I) with variables n, X, Y, R1, R2, R3, R4, R5, etc. . . which do not define a contribution over the prior art. The variables are broadly defined and when taken as a whole result in vastly different compounds. Accordingly, unity of invention is considered to be lacking and restriction of the invention in accordance with the rules of unity of invention is considered to be proper. Additionally, the vastness of the claimed subject matter and the complications in understanding the claimed subject matter imposes a burden on any examination of the claimed subject matter.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sonya Wright, whose telephone number is (703) 308-4539. The examiner can normally be reached on Monday-Friday from 8:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (703) 308-4537. The Unofficial

fax phone number for this Group is (703) 308-7922. The Official fax phone numbers for this Group are (703) 308-4556 or 305-3592.

When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-1235.



Joseph K. McKane

Supervisory Patent Examiner

Group 1600

Sonya Wright

April 23, 2003